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Amendment

REMARKS

Claims 12 and 39-45 have been canceled without prejudice. Forty-one claims remain pending in the application: Claims 1-11 and 13-38 and 46-49. Reconsideration of claims 1-11 and 13-38 and 46-49 in view of the remarks below and the Terminal Disclaimer provided herewith is respectfully requested.

Information Disclosure Statement

Applicants respectfully request that the Examiner consider, initial, and forward a copy of the Information Disclosure Statement (IDS) filed on April 14, 2004. Applicants note that the Examiner forwarded a copy of the aforementioned IDS with a signature at the bottom of the IDS. However, each reference was not individually initialed by the Examiner. According to MPEP 609 subsection III.C:

The information contained in information disclosure statements which comply with both the content requirements of 37 CFR 1.98 and the requirements, based on the time of filing the statement, of 37 CFR 1.97 will be considered by the examiner. Consideration by the examiner of the information submitted in an IDS means that the examiner will consider the documents in the same manner as other documents in Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search. The initials of the examiner placed adjacent to the citations on the PTO-1449 or PTO/SB/08A and 08B or its equivalent mean that the information has been considered by the examiner to the extent noted above.  
(emphasis added)

Therefore, because the IDS filed on April 14, 2004 by Applicants comply with 37 CFR 1.98 and 37 CFR 1.97, it is respectfully

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requested that the Examiner return a copy of the aforementioned IDS with initials next to each of the cited references.

A copy of the aforementioned IDS is attached for the Examiner's convenience.

Election/Restrictions

The Examiner indicated in the outstanding office action that claims 1-12 and 39-49 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

However, claims 1-11 and 46-49 are directed to the same generic group, i.e. group 1, as elected claims 13-38. Group 1 was classified in the restriction requirement mailed July 8, 2004 as class 2, subclass 239 drawn to a sock garment.

Applicants point to 37 CFR 1.141(a) which states:

Two or more independent and distinct inventions may not be claimed in one national application, except that more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims in one national application, provided the application also includes an allowable claim generic to all the claimed species and all the claims to species in excess of one are written in dependent form (§ 1.75) or otherwise include all the limitations of the generic claim. (emphasis added)<sup>1</sup>

Applicants respectfully submit that independent claims 1, 46, and 48 (which the Examiner has withdrawn from consideration) include each of the limitations of elected generic claim 13 including (1) a heel section adapted to receive a heel of the wearer therein, (2) an arch section, and (3) a plurality of separated, closed toe sections to

<sup>1</sup> Also see MPEP 806.04(d)

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receive toes of the foot of the wearer, the toe sections joined by nested, overlapping material portions. Further, dependent claims 2-11, 47, and 49 should likewise be considered because they inherently include each of the limitations of the claim from which they depend (i.e. claims 1, 46, and 48). Therefore, because there is a generic claim (i.e. claim 13) which links each of the above species of the elected group 1, it is respectfully requested that the Examiner consider the patentability of claims 1-11 and 46-49.

Claim Rejection under Obvious Type Double Patenting

Claims 13-38 stand rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1-6, 8, and 10-13 of U.S. Patent No. 6,708,348 of Romay.

In response, Applicants provide herewith a Terminal Disclaimer to Obviate a Double Patenting Rejection Over a Prior Patent ("Terminal Disclaimer") and an authorization to charge Deposit Account No. 06-1135 for any appropriate fees.

Additionally, Applicants submit that after the Examiner's reconsideration of claims 1-11 and 46-49 (for the reasons stated above), any potential rejection based on Obviousness Type Double Patenting for claims 1-11 and 46-49 would also be overcome with the Terminal Disclaimer provided herewith.

Applicants submit that the Terminal Disclaimer overcomes the nonstatutory double patenting rejection, and thus, claims 13-38 as well as claims 1-11 and 46-49 are in condition for allowance.

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Fees Believed to be Due

The director is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number 06-1135.

CONCLUSION

Applicants submit that the remarks and Terminal Disclaimer provided herein place the pending claims in condition for allowance. Therefore, a Notice of Allowance is respectfully requested. However, should there remain any outstanding issues that require adverse action, it is respectfully requested that the Examiner telephone Richard E. Wawrzyniak at (858) 552-1311 so that such issues may be resolved as expeditiously as possible.

Respectfully submitted,

Date: 1/27/05

  
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